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SNELL & WILMER LLP 600 ANTON BOULEVARD SUITE 1400 COSTA MESA, CA 92626			DARNO, PATRICK A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/688,602	Applicant(s) ISHIGURO ET AL.	
	Examiner Patrick A. Damo	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05302006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-11 are pending in this office action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 11 is rejected under 35 U.S.C. 101 because the claim is directed to non-statutory subject matter.

Claim 11 is rejected under 35 U.S.C. 101 because the claims do not specify that the computer program product be embodied on a computer readable medium. A computer program product that is not embodied on an acceptable computer readable medium is nothing more than an abstract idea. When the computer program product is recorded on an acceptable computer readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the computer program product to be realized. Appropriate correction is required.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,249,784 issued to Thomas J. Macke et al. (hereinafter "Macke").

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Claim 1:

Macke discloses a data searching apparatus that searches a database of data files for a desired data file, based on a search condition set by a user, each data file including a plurality of search keys for providing clues to know data file contents, comprising:

a receiving unit operable to receive a search condition from the user (Macke: column 6, lines 57-63; Note here that the searching module (searching unit) accepts three inputs. The searching unit **must** have a receiving unit since it accepts the search conditions input by a user.);

a searching unit operable to search the database for at least one data file that satisfies the search condition received by the receiving unit (Macke: column 6, lines 57-63; This reference clearly discloses a searching unit that must have some form of receiving unit because the searching unit accepts an input. The accepted “search keys” are used to search a database.); and

an extracting unit operable to extract a plurality of search keys, from the data file that is a search result by the searching unit (Macke: abstract, lines 25-28 and column 4, lines 32-38 and column 8, lines 21-28),

wherein the searching unit further searches the database for at least one data file that includes at least one of the search keys extracted by the extracting unit (Macke: abstract, lines 25-28 and column 3, lines 9-13 and column 4, lines 34-38 and column 8, lines 25-28; Note specifically in all the references cited here that particular words or search keys are extracted for the purpose of performing a subsequent search.).

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Claim 2:

Macke discloses all the elements of claim 1, as noted above, and Macke further discloses wherein the extracting unit includes:

a data-file-list displaying unit operable to display a list of data files that are search results by the searching unit (Macke: column 8, lines 21-28; It can be seen by the reference that the Extract Module also contains a “data-file-list displaying unit” which is used to “display actual data to a user so that results can be viewed”.);

a file-selection receiving unit operable to receive, from the user, selection of a data file from the list displayed by the data-file-list displaying unit (Macke: column 8, lines 25-28); and

a selective extracting unit operable to extract search keys, from the data file selected in the file-selection receiving unit (Macke: column 8, lines 20-21).

Claim 3:

Macke discloses all the elements of claim 2, as noted above, and Macke further discloses wherein:

the file-selection receiving unit receives, from the user, selection of a plurality of data files one after another from the list displayed by the data-file list displaying unit (Macke: column 8, lines 25-28), and then receives, from the user, one of (a) a key extraction instruction to extract search keys from each of the selected data files (Macke: column 8, lines 20-28; The user must, in some way trigger the extraction module.) and (b) an output instruction to output each of the selected data files (Macke: column 18, lines 30-34; Shows the user selecting parameter that help determine output.

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The actual command to search would be the user command to generate output. The user must command the searching module of the invention to generate output.),

the selective extracting unit extracts search keys from each of the selected data files when the file-selection receiving unit receives the key extraction instruction (Macke: column 8, lines 20-28),

the searching unit, every time when the file-selection receiving unit receives selection of one or a predetermined number of data files, reads the selected data files and stores therein the read data files (Macke: column 6, lines 57-63), and

the data searching apparatus further comprises:

a result outputting unit operable to output the data files stored in the searching unit when the file-selection receiving unit receives the output instruction (Macke: column 4, lines 9-12).

Claim 10:

A data searching method for searching a database of data files for a desired data file, based on a search condition set by a user, each data file including a plurality of search keys for providing clues to know data file contents, the method comprising:

a receiving step of receiving a search condition from the user (Macke: column 6, lines 57-63; Note here that the searching step accepts three inputs. The searching step must have a receiving step since it accepts the search conditions input by a user.);

a searching step of searching the database for at least one data file that satisfies the search condition received in the receiving step (Macke: column 6, lines

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57-63; This reference clearly discloses a searching step that must have some form of receiving step because the searching step accepts an input. The accepted “search keys” are used to search a database.); and

an extracting step of extracting a plurality of search keys, from the data file that is a search result in the searching step (Macke: abstract, lines 25-28 and column 4, lines 32-38 and column 8, lines 21-28),

wherein in the searching step, the database is further searched for at least one data file that includes at least one of the search keys extracted in the extracting step (Macke: abstract, lines 25-28 and column 3, lines 9-13 and column 4, lines 34-38 and column 8, lines 25-28; Note specifically in all the references cited here that particular words or search keys are extracted for the purpose of performing a subsequent search.).

Claim 11:

A computer program to be executed on a computer for searching a database of data files for a desired data file, based on a search condition set by a user, each data file including a plurality of search keys for providing clues to know data file contents, the program comprising:

a receiving step of receiving a search condition from the user (Macke: column 6, lines 57-63; Note here that the searching step accepts three inputs. The searching step **must** have a receiving step since it accepts the search conditions input by a user.);

a searching step of searching the database for at least one data file that satisfies the search condition received in the receiving step (Macke: column 6, lines 57-63; This reference clearly discloses a searching step that must have some form of receiving

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step because the searching step accepts an input. The accepted "search keys" are used to search a database.); and

an extracting step of extracting a plurality of search keys, from the data file that is a search result in the searching step (Macke: abstract, lines 25-28 and column 4, lines 32-38 and column 8, lines 21-28);

wherein in the searching step, the database is further searched for at least one data file that includes at least one of the search keys extracted in the extracting step (Macke: abstract, lines 25-28 and column 3, lines 9-13 and column 4, lines 34-38 and column 8, lines 25-28; Note specifically in all the references cited here that particular words or search keys are extracted for the purpose of performing a subsequent search.).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macke in further view of U.S. Patent Application Number 2005/0165613 issued to Chung Tae Kim (hereinafter "Chung").

Claim 4:

Macke discloses all the elements of claim 2, as noted above, and Macke further discloses wherein:

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the selective extracting unit extracts search keys for each of the plurality of fields, from the data file selected in the file-selection receiving unit (Macke: column 8, lines 20-28), and

the searching unit includes:

a search-key-list displaying unit operable to display a list of the search keys extracted for each of the plurality of fields by the extracting unit (Macke: column 8, lines 25-28; The user “can...select particular keywords”, so the keywords must be displayed.);

a key-selection receiving unit operable to receive, from the user, selection of at least one search key from the list displayed by the search-key-list displaying unit (Macke: column 8, lines 25-28; Note specifically “The user can...select particular keywords”.); and

a selective searching unit operable to search the database for at least one data file that includes the search key selected in the key-selection receiving unit (Macke: column 6, lines 57-63; The search module is the searching unit.).

Macke does not explicitly disclose wherein the search keys are categorized in a plurality of fields. However, Chung discloses wherein the search keys are categorized in a plurality of fields (Chung: paragraph [0058], lines 1-8; The keywords are the search keys.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Macke with the teachings of Chung noted above for the purpose of categorizing search keys (Chung: paragraph [0058], lines 1-8). The skilled artisan would have been motivated to improve the teachings of Macke per the above such that the search keys can be

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presented to the user on a category-by-category basis (Chung: paragraph [0058], lines 6-8).

Claim 5:

Macke discloses all the elements of claim 1, as noted above, and Macke further discloses wherein:

the extracting unit extracts search keys for each of the plurality of fields, from the data file that is a search result by the searching unit (Macke: column 8, lines 20-28), and

the searching unit includes:

a search-key-list displaying unit operable to display a list of the search keys extracted for each of the plurality of fields by the extracting unit (Macke: column 8, lines 25-28; The user “can...select particular keywords”, so the keywords must be displayed.);

a key-selection receiving unit operable to receive, from the user, selection of at least one search key from the list displayed by the search-key-list displaying unit (Macke: column 8, lines 25-28; Note specifically “The user can...select particular keywords”.); and

a selective searching unit operable to search the database for at least one data file that includes the search key selected in the key-selection receiving unit (Macke: column 6, lines 57-63; The search module is the searching unit.).

Macke does not explicitly disclose wherein the search keys are categorized in a plurality of fields. However, Chung discloses wherein the search keys are categorized in a plurality of fields (Chung: paragraph [0058], lines 1-8; The

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keywords are the search keys.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Macke with the teachings of Chung noted above for the purpose of categorizing search keys (Chung: paragraph [0058], lines 1-8). The skilled artisan would have been motivated to improve the teachings of Macke per the above such that the search keys can be presented to the user on a category-by-category basis (Chung: paragraph [0058], lines

5. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macke in further of U.S. Patent Application Publication Number 2002/0143760 issued to Jin-Kwan Kim et al. (hereinafter "Kim").

Claim 6:

Macke discloses all the elements of claim 1, as noted above, and Macke further discloses wherein the searching unit further searches the database for at least one data file that includes at least one of the frequently-used keywords extracted by the extracting unit (Macke: abstract, lines 25-28 and column 3, lines 9-13 and column 4, lines 34-38 and column 8, lines 25-28; Note specifically in all the references cited here that particular words or search keys are extracted for the purpose of performing a subsequent search.).

Macke does not explicitly disclose wherein the apparatus searches for a patent data file. However, Kim discloses wherein the search apparatus searches for a patent data file (Kim: paragraphs [0016], [0017], and [0034], lines 3-6).

Kim further discloses wherein:

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one type of the search keys is a keyword (Kim: paragraph [0016], lines 3-4 and paragraph [0034], lines 3-6);

the searching unit searches the database for at least one patent data file that includes the keyword (Kim: paragraph [0016], lines 3-4 and paragraph [0034], lines 3-6);

the extracting unit extracts a plurality of frequently-used keywords, from the patent data file that is a search result by the searching unit (Kim: paragraph [0035]), and

the searching unit further searches the database for at least one patent data file that includes at least one of the frequently-used keywords extracted by the extracting unit (Kim: paragraph [0036], lines 6-10 and).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Macke with the teachings of Kim noted above for the purpose of creating a searching apparatus for searching a patent data file containing both a searching unit and an extracting unit (Kim: paragraphs [0016], [0017], [0033], lines 1-7 and [0034], lines 3-6). The skilled artisan would have been motivated to improve the teachings of Macke per the above such that the extracted information is used to perform a subsequent search (Macke: column 8, lines 25-28).

Claim 7:

Macke discloses all the elements of claim 1, as noted above, and Macke further discloses wherein the searching unit further searches the database for at least one data file that includes at least one keyword extracted by the extracting

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unit (Macke: abstract, lines 25-28 and column 3, lines 9-13 and column 4, lines 34-38 and column 8, lines 25-28; Note specifically in all the references cited here that particular words or search keys are extracted for the purpose of performing a subsequent search.).

Macke does not explicitly disclose wherein the searching apparatus searches for a patent data file.

However, Kim discloses wherein the search apparatus searches for a patent data file (Kim: paragraphs [0016] and [0017]).

Kim further discloses wherein:

one type of the search keys is an IPC symbol, where "IPC" represents the International Patent Classification (Kim: paragraph [0051], lines 6-12; Note specifically that the IPC is included in the search strategy.),

the searching unit searches the database for at least one patent data file that includes an IPC symbol (Kim: paragraph [0051], lines 6-12; Kim's invention searches database based upon determined search strategies. The current reference shows that the search strategies for retrieving patents include searching for an IPC.),

the extracting unit extracts a plurality of IPC symbols, from the patent data file that is a search result by the searching unit (Kim: paragraph [0035]; This reference makes clear that Kim extracts IP (intellectual property) information. Paragraph [0051] clearly discloses that for patents, IPC is part of the IP information.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Macke with the teachings of Kim noted above for the purpose of creating a searching apparatus for searching a patent data file containing both a searching unit and an extracting unit (Kim:

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paragraphs [0016], [0017], [0033], lines 1-7 and [0034], lines 3-6). The skilled artisan would have been motivated to improve the teachings of Macke per the above such that the extracted information is used to perform a subsequent search (Macke: column 8, lines 25-28).

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Macke in further in view of U.S. Patent Application Publication Number 2002/0073095 issued to Akihiro Ohga (hereinafter Ohga).

Claim 8:

Macke discloses all the elements of claim 1, as noted above, and Macke further discloses wherein the searching unit further searches the database for at least one data file that includes at least one of the terms extracted by the extracting unit (Macke: abstract, lines 25-28 and column 3, lines 9-13 and column 4, lines 34-38 and column 8, lines 25-28; Note specifically in all the references cited here that particular words or search keys are extracted for the purpose of performing a subsequent search.).

Macke does not explicitly disclose wherein the searching apparatus searches for a patent data file.

However, Ohga discloses wherein the searching apparatus searches for a patent data file (Ohga: paragraph [0007]).

wherein one type of the search keys is an F-term, where "F-term" represents the File Forming Term (Ohga: paragraph [0003], lines 16-17),

the searching unit searches the database for at least one patent data file that includes an F-term (Ohga: paragraph [0024]),

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the extracting unit extracts a plurality of F-terms, from the patent data file that is a search result by the searching unit (Ogha: paragraph [0031], lines 9-14; Note reads F-terms from the F-term database. The F-term database stores patent data files. Reading the F-term from the database is extracting the F-term from the patent data file in the database.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Macke with the teachings of Ogha noted above for the purpose of searching a patent data file (Ogha: paragraph [0007]). The skilled artisan would have been motivated to improve the teachings of Macke per the above such that a patent data file could be searched using both an F-term and an IPC (Ogha: paragraph [0003], lines 16-17).

7. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macke in view of Kim and further in view of U.S. Patent Application Publication Number 2002/0073095 issued to Akihiro Ohga (hereinafter Ogha).

Claim 9:

The rejections of claims 6, 7, and 8 have been presented above in great detail. Claim 9 is rejected under the same reasons set forth in the rejections of claims 6, 7, and 8.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick A. Darno whose telephone number is (571) 272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Patrick A. Darno
Examiner
Art Unit 2163

